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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,829

03/29/2004

James A. Rogers

38-77(52900)F

3656

27161

7590

05/03/2006

MONSANTO COMPANY

800 N. LINDBERGH BLVD.

ATTENTION: GAIL P. WUELLNER, IP PARALEGAL, (E2NA)

ST. LOUIS, MO 63167

EXAMINER.

ROBINSON, KEITH O NEAL

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/812,829	Applicant(s) ROGERS ET AL.	
	Examiner Keith O. Robinson, Ph.D.	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5,10,12,13 and 21 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 5,10-13 and 21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claim 5, drawn to a hybrid maize seed, classified in class 800, subclass 320.1, for example.
  - II. Claims 10, 12 and 13, drawn to a method of breeding maize, classified in class 800, subclass 275, for example.
  - III. Claim 21, drawn to a method of associating a seed oil-related trait to a genotype in maize, classified in class 800, subclass 267, for example.

Applicant has cancelled claims 1-4, 6-9 and 14-20 in an amendment filed March 21, 2005. Claims 5, 10-13 and 21 are pending and are restricted for reasons discussed below.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions can be shown that they are not disclosed as capable of use together. For example, the hybrid maize seed of invention I is produced by crossing two parental maize lines wherein at least one parent is a transgenic maize line. The use of a transgenic maize line is not necessary for invention II, which uses a breeding population and does not require the use of a hybrid.

Furthermore, searching the invention of group I together with the invention of

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group II would impose a serious search burden. In the instant case, prior art searches of a hybrid maize seed are not coextensive with prior art searches of a method of breeding maize. Search of each of these inventions would require different key word searches of each compound and of each distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and II together.

3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions can be shown that they are not disclosed as capable of use together. For example, the method of invention III does not require the use of hybrid maize plants.

Furthermore, searching the invention of group I together with the invention of group III would impose a serious search burden. In the instant case, prior art searches of a hybrid maize seed are not coextensive with prior art searches of a method of associating a seed oil-related trait to a genotype in maize. Search of each of these inventions would require different key word searches of each compound and of each distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of

the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions I and III together.

4. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operation. For example, the steps required for invention II are different and unique from those of invention III.

Furthermore, searching the invention of group II together with the invention of group III would impose a serious search burden. In the instant case, prior art searches of a method of breeding maize are not coextensive with prior art searches of a method of associating a seed oil-related trait to a genotype in maize. Search of each of these inventions would require different key word searches of each compound and of each distinctive step of the method using divergent patent and non-patent literature databases. The different searches would then require subsequent in-depth analysis of the unrelated prior art literature, placing a serious burden on the Office in terms of both search and examination. As such, it would be burdensome to perform examination of inventions II and III together.

5. Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject

matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith O. Robinson, Ph.D. whose telephone number is 571-272-2918. The examiner can normally be reached on Monday - Friday 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

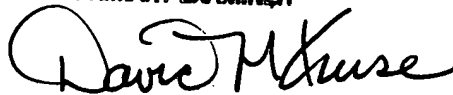
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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith O. Robinson, Ph.D.

April 13, 2006

DAVID H. KRUSE, PH.D.  
PRIMARY EXAMINER

A handwritten signature in black ink that reads "David H. Kruse". The signature is written in a cursive style with a large, looped "D" and a stylized "K".